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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,005	06/21/2001	Kazuo Kuroda	1767-83	3546
23117	7590	10/06/2005	EXAMINER	
NIXON & VANDERHYE, PC			SHIBRU, HELEN	
901 NORTH GLEBE ROAD, 11TH FLOOR			ART UNIT	
ARLINGTON, VA 22203			PAPER NUMBER	

2616

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/885,005

Applicant(s)

KURODA ET AL.

Examiner

SHIBRU HELEN

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>09/03/04, 04/27/05</u> | 6) <input type="checkbox"/> Other: _____ |

Information Disclosure Statement

1. The information disclosure statement filed on 4/27/2005 fails to comply with 37 CFR 1.97(c) because it lacks a statement of relevance for each citation not in the English language. The foreign reference have been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 31-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support in the disclosure to describe what a computer signal is and how is such a computer signal is being embedded for carrier wave as claimed.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-2, 4-13, 15-20, and 27-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Utsumi (US Pat. No. 6,400,667).

Regarding claim 1, Utsumi discloses outputting apparatus comprising:

an outputting device for outputting main information composed of a plurality partial of partial information (see col. 33 lines 21-25) to an information recording apparatus together with order information (see col. 33 lines 14-20), which shows configuration order of said respective partial information said information, in said main information, along a reproduction time series main information (see col. 33 line 56-col.34 line 6);

a controlling device (see controller (11) in fig. 1) for controlling the outputting device so as to repeatedly perform outputting operation with respect to the same said main information and said order information (see 39 lines 27-43 and col. 44 lines 30-40).

Claim 12 is rejected for the same reason as discussed in claim 1 above.

Regarding claim 2, Utsumi discloses information recording apparatus records said outputted main information in a recording medium by using said outputted order information so that said main information is reproduced on the basis of said order information (see col. 11 lines 29-32 and col. 44 lines 19-25).

Claim 13 is rejected for the same reason as discussed in claim 2 above.

Regarding claim 4, Utsumi discloses outputting apparatus further comprises a distributing device for distributing said main information and said order information to said information recording apparatus through telecommunication lines (see col. 8 lines 38-47, external apparatus).

Claim 15 is rejected for the same reason as discussed in claim 4 above.

Note to the Applicant: The USPTO considers the Applicant's "or" language to be anticipated by any reference containing one of the subsequent corresponding elements.

Regarding claim 5, Utsumi discloses telecommunication lines comprise a cable television circuit (see col. 8 lines 48-54).

Regarding claim 6, Utsumi discloses outputting device also outputs reproduction controlling information for controlling a reproduction manner of said main information recorded in said recording medium to said information recording apparatus together with said main information and said order information (see col. 9 lines 36-58 and col. 45 lines 24-30).

Regarding claim 7, Utsumi discloses main information includes regulating information for regulating the number of times for copying after said main information is recoded in said recording medium (see col. 20 line 64-col. 21 line 15),

said outputting device further comprises a changing device for uniformly changing said respective order information in association with a content of the included regulating information and generating a changing order information (see col. 21 lines 26-38), and

said outputting device outputs said changing order information to said information recording apparatus together with said main information (col. 20 lines 1-17).

Claim 16 is rejected for the same reason as discussed in claim 7 above.

Regarding claim 8, Utsumi discloses partial information comprises an information sector (see col. 11 lines 24-32), and

said order information is any one of sector address information in association with said respective information sectors and relative information which is related to said sector address information (see col. 11 line 66-col. 12 line 6 and col. 15 lines 3-7).

Regarding claim 9, Utsumi discloses an information recording apparatus for recording main information which are outputted from an information outputting apparatus, in a recording medium (see col. 9 lines 53-58 and col. 33 lines 21-25 and 34-40) wherein the information outputting apparatus comprises: an outputting device for outputting main information composed of a plurality partial of partial information (see col. 33 lines 21-25) to an information recording apparatus together with order information (see col. 33 lines 14-20), which shows configuration order of said respective partial information said information, in said main information, along a reproduction time series main information (see col. 33 line 56-col.34 line 6); a controlling device (see controller (11) in fig. 1) for controlling the outputting device so as to repeatedly perform outputting operation with respect to the same said main information and said order information (see 39 lines 27-43 and col. 44 lines 30-40), wherein said information recording apparatus comprises:

an obtaining device for obtaining said outputted main information and said outputted order information (see col. 42 line 63-col. 43 line 5); and

a recording device for recording said obtained main information in said recording medium by using said obtained order information in the order of obtaining (see col. 8 line 29-47).

Claims 18 and 27 are rejected for the same reason as discussed in claim 9 above.

Regarding claim 10, Utsumi discloses address information showing a recording position on said recording medium is recorded in advance on said recording medium (see col. 35 line 59-col. 36 line 9), and

said recording device records said partial information in association with said order information on a recording position on said recording medium, which is indicated by said address information associated with said obtained information (see col. 15 lines 3-12).

Claims 11, 17, and 20 are rejected for the same reason as described in claim 8 above.

Claims 19 and 28 are rejected for the same reason as discussed in claim 10 above.

Claim 29 is rejected for the same reason as discussed in claim 8 above.

Regarding claim 30, the claim limitations of claim 30 can be found in claims 1 and 9 above. Therefore claim 30 is analyzed and rejected for the same reason as discussed in claims 1 and 9.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3, 14, 21-26, and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Utsumi.

8. Regarding claim 3, although Utsumi does not specifically teach main information is compressed having no relation to a time axis, Utsumi does teach the transfer rate is different when it is written in to the ATRAC data area and read out from the memory (see col. 40 lines 18-26). Therefore, Official Notice is taken that it would have been obvious to one of ordinary skill in the art at the time the invention was made to compress main information having no relation with a time axis in order to select different available compression method.

Claim 14 and 23 are rejected for the same reason as discussed in claim 3 above.

Regarding claim 21, the limitations in this claim can be found in the apparatus claim 1. However claim 21 further requires a recording medium for storing a program causing the computer to execute steps as claimed in claim 1. Official notice is taken that it is well known in the art to embody inventions in software to be executed by a computer. Therefore, it would have been obvious to one of ordinary skill in the art to modify the teaching of Kawamura by having a record medium capable of being read by a computer tangibly embodying a program causing the computer to execute the steps of the method claim. The motivation for having a recordable by a computer is that such a method can be easily enhanced and executed multiple times.

Regarding claim 31 and 32, the limitations in claims 31 and 32 can be found in the apparatus claim 1 and 9 respectively. However claims 31 and 32 further require a computer data signal to perform steps as claimed in claims 1 and 9. Official Notice is taken that it is well known in the art to embody inventions in software to be executed by a computer. Therefore, it would have been obvious to one of ordinary skill in the art to modify the teaching of Kawamura by having a record medium capable of being read by a computer tangibly embodying a program causing the computer to execute the steps of the method claim. The motivation for having a recordable by a computer is that such a method can be easily enhanced and executed multiple times.

Claim 22 is rejected for the same reason as discussed in claim 2 above.

Claim 25 is rejected for the same reason as discussed in claim 16 above.

Claim 26 is rejected for the same reason as discussed in claim 10 above.

Regarding claim 24, the limitations of claim 24 can be found in claim 4 and 21 above.

Therefore, claim 24 is analyzed and rejected for the same reason as discussed in claim 4 and 21 above.


Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen Shibru whose telephone number is (571) 272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Helen Shibru
October 3, 2005


DAVID L. OMETZ
SUPERVISORY PATENT
EXAMINER